

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Application of: Wood, Michael Tate Examiner: Picket, John G.
Application Number: 10/804,458 Art Unit: 3765
Filed: March 19, 2004 Confirm No.: 7254

For: SIDE OPEN GUN CASE

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Further to Appellant's Notice of Appeal filed January 20, 2009, an Appeal Brief is submitted herewith. This is an Appeal from the final rejection of claims 1-4 of the subject application. No claims stand allowed.

REAL PARTY IN INTEREST

The real parties in interest are the joint inventors, Michael Tate Wood and Bobby Lee Windham.

RELATED APPEAL PROCEEDINGS

None

STATUS OF CLAIMS

Claims 1-4 are pending in the application, and all claims 1-4 stand rejected. The rejection of all claims 1-4 is appealed. See Appendix A for a copy of the claims under Appeal.

STATUS OF AMENDMENTS

On July 7, 2008 Appellants timely filed an Amendment in response to the Examiner's non-final office action of January 7, 2008, which Amendment was entered by the Examiner. The Examiner mailed a final Official Action rejecting all claims on October 20, 2008. Appellants filed an Amendment pursuant to 37 CFR 1.116 contemporaneously with the Notice Of Appeal on January 20, 2009 and was advised by the Examiner's Advisory Action of February 9, 2009 that the Rule 116 Amendment was not entered. Thus, the status of the claims is as filed pursuant to the Appellants' Amendment on July 7, 2008.

SUMMARY OF CLAIMED SUBJECT MATTER

With reference to the published application no. 20050011786, the present invention is a gun case 5 that fully encloses and securely bears the weight of a long-arm gun, and yet which can be *completely opened and completely inverted* for easy access and drying [page 1, para. 007 and FIGS. 1, 2 and 3]. The gun case is especially suitable for duck hunting and like trips in wetlands where a gun will collect moisture during use, which moisture inevitably collects in the gun case after the gun is stored therein. This is achieved with a double-layer fabric construct including a waterproof outside shell fabric 6, shown in FIGS. 1 and 2, integrally sewn to paraffin-impregnated inside lining fabric 7, the two fabrics being uniformly cut in an elongate form and sewn together as shown in FIG. 3, and reinforced along their periphery with a rolled fabric strip overlying the edges. [page 2, paras. 18-19 and FIG. 3]. The gun case 5 when closed takes a quadrilateral form conforming to the shape of a long-arm gun, elongated with a narrowed end to accommodate a gun muzzle and a widened end to accommodate a gun butt. Padding is disposed between the outside fabric 6 and the inside fabric 7 to cushion the gun as it is transported, and also to maintain the buoyancy of the gun case 5. [Page 2, para. 19] The gun

case 5 is sewn shut along one major side and the narrow. The open side and end are configured with conjoined fold-over flaps 8, 9 that may be opened or closed as desired. [Page 2, para. 20]. Specifically, one flap 9 is located along, and occupies a significant portion of the length of the gun case 5 and is movable between a closed, or open position allowing side access to the enclosure. [Page 2, para. 20 and FIG. 3]. The other fold-over flap 8 is located at the end and this is likewise movable between an open position for allowing end-access to the enclosure. [page 2, para. 20 and FIG. 3]. The lengthwise flap 9 is secured first, preferably by opposing hook-and-loop patches. Then the end flap 8 is secured over the lengthwise flap by similar means to form a secure double-closure [see FIG. 1]. For the full inversion feature noted above, it is essential that the first flap 8 opening conjoins the second flap 9 opening, so that when both flaps are pulled back the gun case is fully open along the corresponding major side and end, and can be completely inverted. Long guns deposit damaging moisture and abrasive material into the case 5, which can be transferred back into the gun if the case is not thoroughly clean and dried. Advantageously, this inverted gun case 5 can be hung over a line for quick and convenient cleaning and/or drying out. [page 2, para. 20] Additionally, the inside fabric 7 is impregnated with oil so that a small quantity of oil will be applied to a gun during the process of inserting and removing it from the gun case 5.

With particular regard to independent claim 1, the foregoing limitations appear as "a fabric enclosure formed by a fabric outer shell sewn to a padded inner liner and reinforced around a peripheral seam [page 2, paras. 18-19 and FIG. 3], said shell and padded inner liner being folded lengthwise and sewn together at one end to form an elongate enclosure permanently closed along one side and said end, and with conjoined sidelong and end access openings, [page 2, para. 18 and FIGs.1-3], a first foldover flap movable between an open position and a closed position releasably secured over said end access opening to prevent access to the fabric

enclosure, and a second foldover flap movable between an open position and a closed position releasably secured over said sidelong access opening to prevent access to the fabric enclosure [page 2, para. 20 and FIG. 3], whereby when both of said first and second flaps are moved to their respective open positions to fully expose said conjoined sidelong and end access openings they allow the gun case to be quickly turned inside out for cleaning and/or drying. [page 1, para. 007 and FIGS. 1, 2 and 3]

The above constitutes a concise explanation of the invention as defined in independent claim 1 involved in the Appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following is a concise statement of each ground of rejection presented for review. There is a single categorical ground of rejection as set forth as follows:

1.) Whether claims 1, 2 and 3 are unpatentable under 35 U.S.C. §103(a) as obvious over U.S. Patent Publication No. US 2003/0106819 A1 by Bennett ("Bennett") combined U.S. Patent No. 6,256,922 to Jones ("Jones")? Claim 4 is not separately argued on Appeal but stands or falls with the claims on which it depends.

ARGUMENT

1.) Whether claims 1, 2 and 3 are unpatentable under 35 U.S.C. §103(a) as obvious over U.S. Patent Publication No. US 2003/0106819 A1 by Bennett ("Bennett") combined with U.S. Patent No. 6,256,922 to Jones ("Jones")?

The Examiner rejected claim 1 under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Jones. The Examiner contends that Bennett discloses all elements of claim 1 save for the sidelong opening and fabric outer shell. Applicant disagrees. Careful inspection of the Bennett application reveals that the case taught therein does not disclose that for which the

Examiner credits it. Similarly, careful inspection of the Jones patent reveals that the Examiner unduly credits that disclosure as well.

The Examiner asserts that the fabric outer shell and a padded inner liner recited in present claim 1 is disclosed at Fig. 3 and paragraph [0011] of Bennett.¹ Applicant disagrees and observes that the Examiner's reference to the non-woven fabric 28 as "padding" is based entirely on his own presumption. The non-woven fabric 28 of Bennett is never referred to in the disclosure as "padding." The specification specifically recites that non-woven fabric 28 is provided to retain applied gun oils or lubricants in contact with the weapon while soaking up excess lubricant and is preferably a thin felt or non-woven polypropylene that may be impregnated with preservative, absorbents or desiccants such as silicon oil. Bennett ¶¶ [0014-0015]. No where does Bennett suggest the use or inclusion of padding as disclosed in the present invention but rather teaches otherwise. The Examiner states in his Response To Arguments in the Official Action of October 20, 2008 (page 5, § 5) that the material is sufficient to constitute recitation of this limitation because it is capable of performing this function, essentially stating that padding is an inherent characteristic of all non-woven fabrics.

The fact that a certain characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency the evidence must make it clear that the missing matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. It is not sufficient a certain characteristic may be present.

¹ Appellant and Examiner both identified an inconsistency in the disclosure of Bennett as between the written specification and the depiction of Figure 3. Specifically, although Figure 3 depicts the laminated gun case material as having film 26 inside of non-woven fabric 28, the specification recites at [0005] and [0011] that the non-woven fabric is located on the inner surface of the material. It is believed the arrangement of the specification is as intended.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has failed to present any basis in fact or technical reasoning in support of his determination that all non-woven fabric is inherently padding. In fact, many non-woven fabrics have substantially no padding ability.

According to the Examiner, Bennett discloses an end opening having a fold over flap moveable between an open and closed position over the end opening. The Examiner observes that Bennett does not disclose a sidelong access opening or a continuous fold over flap moveable between an open and closed position over the sidelong access opening but asserts that Jones teaches such a sidelong opening and continuous flap and that it would have been obvious to one skilled in the art to combine the references to achieve the conjoined sidelong and end opening of the present invention. Since neither Bennett nor Jones pursue Applicant’s stated goal, and since the Examiner has not articulated any motivation for one skilled in the art to attempt the combination for the stated goal, Applicant here again disagrees.

Applicant respectfully submits that its gun case employs a particular flap arrangement that permits the entire gun case to be easily inverted for internal cleaning. This is made possible by a gun-insertion opening covered by a first flap, and a *conjoined* sidelong opening running substantially the length of the gun case and covered by a second elongate flap. The synergy found in these combined features is recited in the whereby clause of claim 1, which states “*whereby when both of said first and second flaps are moved to their respective open positions to fully expose said conjoined sidelong and end access openings they allow the gun case to be quickly turned inside out for cleaning and/or drying.*” This is clearly not possible with Bennett

because the only access opening is a small gun-insertion end opening through which the gun case cannot readily be inverted, and there is only one flap. The addition of Jones does not change this.

The Examiner credits Jones with disclosing a storage case with a sidelong opening and continuous covering flap. Jones, however, is not a storage case as is the present invention and does not present a single sidelong opening/flap to envelope and protect a firearm. Rather, Jones discloses a firearm jacket with multiple flaps and openings each separately operable to expose the trigger, cartridge, sight and other elements of the firearm to permit use and operation of the gun while encased in the firearm casing. Bennett Col. 1 lns 9-13. Jones does not teach or suggest applicant's flap arrangement which facilitates inversion for cleaning. Nevertheless, the Examiner combines Bennett's end opening/flap with Jones' sidelong opening covered by a flap (Figure 1, portions denoted by numbers 100, 200, 50, 60, 90, and contends that it would have been obvious to make the two openings contiguous.

In support of this the Examiner simply states in his final response to Appellant's argument that "[t]he flaps of Jones are of unitary construction with the casing and therefore would be considered continuous (Figure 7)." Official Action of October 20, 2008 at pg. 5, § 5. Note that FIG. 7 is only a partial view of Jones' device showing just the lower portion of the inside of the firearm casing 10. This does not support the Examiner's contention that the flaps of Jones are of unitary construction with the casing and therefore would be considered continuous. They are not. If Jones taught the continuous sidelong opening that the Examiner asserts it would simply fall off of the firearm when opened for use as directed by Jones. Indeed, it is clear in FIGs. 1 and 10 that Jones teaches distinct side and end flaps/openings, and not an "elongate enclosure permanently closed along one side and said end, and open along a majority of another side and end and defining conjoined sidelong and end access openings." Jones does not teach or suggest this because he is not at all concerned with inverting the device for cleaning. Therefore,

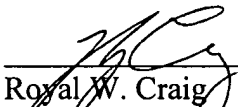
there is absolutely no support for the Examiner's conclusion that "Once modified with a sidelong opening at the rear and mid portions, Bennett-Jones would have a *conjoined* sidelong and end access opening and be fully capable of being turned inside-out." This is hindsight reasoning. Bennett-Jones would not have a conjoined sidelong and end access openings, and turning the item inside-out is not an intended use but an express limitation recited in claim 1 which cannot be ignored.

In sum, Neither Bennett nor Jones, alone or in combination, teach or suggest applicant's structure or function such that claim 1 is distinguished. Specifically, the references fail to disclose a padded inner liner or a continuous sidelong opening and flap that together with the end opening form a conjoined sidelong access to allow the gun case to be quickly turned upside out for cleaning or drying. As such the references are an improper foundation which to base the rejection and claim 1 is patentably distinguished. Claims 2 through 4 are additional recitations dependent on claim 1 that stand or fall with claim 1.

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For the reasons set forth herein, it is believed that the Examiner erred and that this application clearly and patentably distinguishes over the prior art and is in proper condition for allowance. Reversal is respectfully requested.

Respectfully submitted,



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APPENDIX A: CLAIMS APPENDIX

1. A gun case for storage of a long gun, comprising:

a fabric enclosure formed by a fabric outer shell sewn to a padded inner liner and reinforced around a peripheral seam, said shell and padded inner liner being folded lengthwise and sewn together at one end to form an elongate enclosure permanently closed along one side and said end, and open along a majority of another side and end and defining conjoined sidelong and end access openings, a first foldover flap movable between an open position and a closed position releasably secured over said end access opening to prevent access to the fabric enclosure, and a second continuous foldover flap movable between an open position and a closed position releasably secured over said sidelong access opening to prevent access to the fabric enclosure,

whereby when both of said first and second flaps are moved to their respective open positions to fully expose said conjoined sidelong and end access openings they allow the gun case to be quickly turned inside out for cleaning and/or drying.

2. The gun case of claim 1, wherein said conjoined sidelong and end access openings are selectively closable with fold-over flaps attached by hook and loop fasteners.

3. The gun case of claim 1, wherein said padded inner liner includes a woven facing that is impregnated with a rust preventative to inhibit corrosion of a gun stored therein.

4. The gun case of claim 1, further comprising padding disposed between the fabric outer shell and padded inner liner to cushion the gun as it is transported, and to maintain the buoyancy of the gun case so that it floats even with a gun contained therein.

APPENDIX B: EVIDENCE APPENDIX

None

APPENDIX C: RELATED PROCEEDINGS APPENDIX

NONE